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Expedited Procedure under 37 CFR 1.116

Group Art Unit: 1615

TECH CENTER 1600/2900

Attorney Docket No.: P-2769-US6



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

10/B (X/E)

Applicant(s): STEINER, Mitchell S. et al. Examiner: FUBARA, B.

Serial No.: 09/707,766 Group Art Unit: 1615

Best
12-30-02

Filed: November 8, 2000

OK to enter 1/8/03 BFC

Title: METHOD FOR CHEMOPREVENTION OF PROSTATE CANCER

AMENDMENT

Box AF
Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This Amendment is filed in response to the Office Action dated December 3, 2002 issued by the United States Patent and Trademark Office in connection with the above-identified Application. A response to the December 3, 2002 Office Action is due March 3, 2003. Accordingly, this Amendment is being timely filed.

Kindly amend the above-identified application as follows:

In the Specification:

On page 1 line 5 please insert the following:

--CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a continuation-in-part application of U.S. Patent Application No. 09/531,472, filed March 20, 2000, now U.S. Patent No. 6,413,533; and U.S. Patent Application No. 09/660,184, filed September 12, 2000, now U.S. Patent 6,413,534; U.S. Patent Application No. 09/660,191, filed September 12, 2000, now U.S. Patent 6,410,043; U.S. Patent Application No. 09/660,197, filed September 12, 2000, now U.S. Patent

B1

36

B

Office Action Summary	Application No.	Applicant(s)	
	09/707,766	STEINER ET AL.	
	Examiner	Art Unit	
	Blessing M. Fubara	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of request for extension of time and amendment A filed 08/21/02 and change of address filed 11/08/02.

Claim Rejections - 35 USC § 112

1.

2. The rejection of claims 1-25 under first and second paragraphs of 35 U.S.C. 112 is withdrawn because claims 1-25 are cancelled and new claims new claims 26-59 overcome the rejection.

The objection to claims 7-25 is withdrawn because the new claims overcome the objection.

Claim Rejections - 35 USC § 103

3. The rejection of claims 1-25 under 35 U.S.C. 103(a) as being unpatentable over DeGregorio et al. (US 5,491,173) in view of Swindell et al. (US 6,080,877) is withdrawn and the rejection would not apply to new claims 26-59 because the prior art does not teach a method of suppressing or inhibiting latent prostate cancer.

Double Patenting

Claims 26-59 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,265,448, over claims 1-34 of US 6,413,533, over claims 1-17 of US 6,413,534, over claims 1-17 of US 6,410,943, and over claims 1-20 of US 6,413,535.

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Applicants indicated in the response filed 08/21/02 that a terminal disclaimer will be presented upon indication of allowable subject matter. Since the rejection is free of art except for the obviousness type double patenting rejection, applicants are encouraged to provide the terminal disclaimer to overcome the remaining rejection.

OTHER MATTERS

It is requested that applicants amend the specification to insert on page one of the specification, between the title and the field of the invention, the cross-reference to related applications. It is noted that the application is a CIP of application serial #s 09/436,208 and 09/531,472. The amendment to the specification should include this and any other provisional or non-provisional for which this application claims priority of. If any of these applications are now patents, the patent numbers should also be listed.

4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara
November 29, 2002


THURMAN K. PAGE
SUPERV/SOFT PATENT EXAMINER
TECHNOLOGY CENTER 1600